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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/000,256	11/01/2001	Yongming Sun	DEX-0259	9044
26259	7590	08/25/2004	EXAMINER	
LICATLA & TYRRELL P.C. 66 E. MAIN STREET MARLTON, NJ 08053			STRZELECKA, TERESA E	
			ART UNIT	PAPER NUMBER
			1637	

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

10/000,256

Applicant(s)

SUN ET AL.

Examiner

Teresa E Strzelecka

Art Unit

1637

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
2. ☒ The proposed amendment(s) will not be entered because:  
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ they raise the issue of new matter (see Note below);  
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: The amendment to claim 1 requires new consideration.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-5, 7, 8, 15.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.  
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.  
10. ☐ Other: \_\_\_\_\_

GARY BENZION  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

Continuation of 5. does NOT place the application in condition for allowance because:

Applicants' arguments were not found to be persuasive. Specifically, Applicants argue that it is clear from the description on page 116, lines 10-12, that the source of SEQ ID NO: 84 were tissues from patients with cancer. However, no such information is provided on page 116, lines 10-12. The lines cited by Applicants read "CLASP is a set of algorithms that interrogate Incyte's database to identify genes that are both specific to particular tissue types as well as differentially expressed in tissues from patients with cancer." What is not clear here is what information is contained in the Incyte database, i.e., whether the expression information was obtained directly from patients' tissues or from cell cultures. Secondly, Applicants argue that to qualify as CLASP2 marker a gene "must exhibit detectable expression in tumor tissues and undetectable expression in libraries from normal individuals and libraries from normal tissue obtained from diseased patients". However, the most important criterium is what is the relative level of expression in tumors vs. normal tissue, and the statement that it the expression is "detectable" in tumor tissue and "undetectable" in normal tissue does not address this point, since it is not known what levels were considered "detectable" and "undetectable". Further, a gene which is expressed in breast tumors and not expressed in normal breast tissue may be also expressed in ovaries, for example. None of these issues are addressed by Applicants disclosure, therefore Applicants arguments are not persuasive with respect to the utility rejection.

With respect to the written description rejection, Applicants argue that they had an example of a nucleic acid hybridizing to SEQ ID NO: 84, namely, SEQ ID NO: 3. However, this is only one sequence out of a genus of hundreds of thousands of sequences, so it is no representative of the genus, therefore Applicants' arguments did not overcome the written description rejection. .

With respect to art rejections, Applicants argue the amended claims, but since the amendment was not entered, the rejections are maintained.